

REMARKS/ARGUMENTS

The Office rejected claims 29-37, 39-42, and 47 as being unpatentable over Buecker (U.S. Patent No. 6,131,362) in view of Bodnar (U.S. Patent No. 5,207,045). The Applicant respectfully disagrees, especially in view of the claim amendments made to claim 29.

As explained below, the cited references: i) fail to teach or suggest all claim limitations; ii) lack a reasonable expectation of success; and iii) do not provide motivation to combine.

Claim 29 has been amended to include the structure of a joist (*i.e.* a span that is greater than its height). It is important to note that while Buecker may teach a joist, the combination of Buecker and Bodnar does not teach or suggest the device recited in claim 29. For instance, if the web taught in Bodnar were combined with the structure shown in Fig. 5 of Buecker a significant claimed distinction would still exist. That is, the combination still would not teach or suggest a weight bearing element wherein at least two of the 5 sides of the chord are substantially parallel to the web. It is clear from viewing Fig. 5 of Buecker that if a web were added in place of the bridging (80), it would be perpendicular to the two sides of the chord (20 and 22) instead of parallel.

The distinction described in the previous paragraph is very important because the strength of the weight bearing element recited in claim 29 comes, at least in part, from the orientation of the chord in relation to web. Thus, the references, even if combined, would not have resulted in a joist having a reasonable expectation of success. Based on the lack of a reasonable expectation of success, the obviousness rejection must fail pursuant to *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Not only should the rejection fail for the reasons stated above, but also because the examiner has not provided the motivation to combine references. It is the examiner's affirmative duty to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Here, the examiner has not provided such motivation, and therefore the rejection should fail for this reason too.

New claim 48 recites that at least a portion of the flange extends in a direction normal to the span. This is apparent from the figures, and makes sense from a structural standpoint. Since

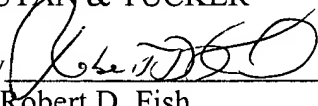
the weight is normal to the span when the device is installed, the flange only provides increased weight bearing capability to the extent that flange is normal to the span.

The applicant respectfully requests submits that independent claim 29 and all dependent claims are in condition for allowance.

Respectfully submitted,

RUTAN & TUCKER

By


Robert D. Fish

Reg. No. 33,880

Tel.: (714) 641-5100